

REMARKS

Claims 19 and 20 have been cancelled. Claims 1, 2, 4, 6, 11 and 17 have been amended. Claim 21 has been added. Accordingly, Claims 1-2, 4-6, 8, 10-11, 13, 15-18 and 21 remain pending in this application.

Applicants' Interview Summary

Applicants first wish to express sincere appreciation for the time that the Examiner spent with Applicants' Attorney, Andrew T. Pham, during a telephone discussion on January 7, 2004, regarding the outstanding Office Action. Applicants believe that certain important issues were identified during the telephone discussion, and that they are resolved herein. During that conversation, the Examiner seemed to indicate that it would be potentially beneficial for Applicants to make the amendments herein. Thus, Applicants respectfully request that Examiner carefully consider this response and the amendments.

With regard to the substance of the interview, Applicants proposed deletion of the "actuator" element from Claims 1 and 4. Applicants also argued that the "substantially horizontal" limitation distinguishes the present invention over the cited references. In addition, the Examiner and Applicants discussed the operation of the safety mechanism in which the Examiner stated that the prior art provides a safety mechanism by the mere fact that the auger is inoperable in a storage position.

Drawings Objection

The drawings were objected to under 37 C.F.R. 1.83(a) for failure to show every features of the invention, particularly the actuator and the hydraulic actuator features. In response, Applicants have canceled the actuator and the hydraulic actuator features from the claims. Accordingly, the objection to the drawings should be removed.

Section 103(a) Rejection

On the merits, Claim 1-2, 4-6, 8, 10-11, 13, and 15-20 were rejected under 35 U.S.C. 103(a) as being unpatentable over Hansen in view of Mooney.

Independent Claim 1

Claim 1, as now presented, recites the first segment and the second segment are pivoted in a substantially horizontal plane between a storage position and coaxially connected unloading position. By restricting the movements of the segments to the horizontal plane, the present invention provides a compact profile for the combine and auger, thereby facilitating storage of the combine and auger.

Neither Hansen nor Mooney, singly or combined, teach or suggest the segments are pivoted in a substantially horizontal plane. In fact, the drawing of Hansen (Fig. 11), cited on page 3 of the Office Action of December 10, 2003, shows a sloping (i.e., slanted and not horizontal) auger. Mooney's drawings also teach a sloping auger. Thus, not only

do the cited references fail to anticipate the above feature, the cited references teach away from the horizontal deposition of the segments.

Teaching away is the antithesis of the art's suggestion that one of ordinary skill in the art move in the claimed direction. Essentially, teaching away is from the art is a *per se* demonstration of lack of *prima facie* obviousness. *In re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Furthermore, MPEP Section 2144.05 affirms that "[a] prima facie case of obviousness ... [is] rebutted by showing that the art, in any material respect, teaches away from the claimed invention." As discussed above, the cited references teach away from the claimed invention by teaching a slanted sloping auger which is completely the opposite of the horizontally disposed segments of the present invention. Accordingly, Claim 1 is believed to be distinguishable over the Hansen and Mooney.

In view of the distinctions noted and the advantages attendant thereto, it is respectfully submitted that Claim 1, as now presented, distinguishes over Hansen and Mooney and is believed to be patentable thereover. Claims 2 and 4-5, which are dependent upon Claim 1, are believed to be patentable along with parent Claim 1.

With regard to the claims dependent upon Claim 1, dependent Claim 2, as now presented, recites a lockable hinge disposed between the first segment and second segment. This lockable hinge fastens the first segment to the second segment, thereby

making the auger more secure and stable. Hansen and Mooney do not teach or suggest this feature. Therefore, Claim 2 is patentable thereover.

Furthermore, with regard to Claim 4, during the telephone interview of January 7, 2004, the Examiner stated that grain is inherently prevented from being released when one of the segment is in the storage position. Applicants disagree because the outfeed section can operate with one segment or with the second segment in the storage position, meaning that the auger does not have to stop operating when the second segment is in the storage position (emphasis added). Although the storage position is used to compactly store the combine, the storage position does not necessitate "a stop" operation for the auger. For example, the auger can still operate in a storage position if the "work" necessitate a shorter outfeed position. As can be seen, there may be applications in which the auger is operating in a "shorten" outfeed position (similar to a storage position). Thus, grain is not inherently prevented from being accidentally released in a storage position.

In view of the distinctions noted and the advantages attendant thereto, it is respectfully submitted that Claim 4, distinguishes over Hansen and Mooney and is believed to be patentable thereover. Claim 5, which is dependent on Claim 4, is believed to be patentable along with Claim 4.

Independent Claim 6

Claim 6, as now presented, is generally similar to Claim 1 by reciting that the first segment and the second segment are horizontally disposed when the auger is disposed in the storage position and in the unloading position. Thus, Claim 6 distinguishes over Hansen and Mooney for the reasons given above and is believed to be patentable thereover.

Claims 8, 10, 11, 13 and 16, which are dependent on Claim 6, are believed to be patentable along with the parent Claim 6.

Furthermore, Claim 10 recites that no portion of the first segment and the second segment extends beyond the rearmost end of combine when the auger is in the storage position. This feature further enhances the compact design profile of the combine of the present invention and facilitates the storage of the combine. Neither Hansen nor Mooney, singly or combined, teach or suggest that that auger remains inside the rearmost end of the combine while in the storage position. Thus, Claim 10 is patentable thereover.

Applicants further submit that neither Hansen nor Mooney teach or suggest the feature of Claim 11, which recites that the hinged joint is lockable when the auger is in the unloading position. Locking the hinged joint provides stability to the auger when the auger is in the unloading position. Neither Hansen nor Mooney teach or suggest the interlocking of the segments. Thus, Claim 11 is also patentable thereover.

Independent Claim 17

Claim 17 is generally similar to Claims 1 and 4 by reciting the first segment and the second segment are pivoted in a horizontal plane between a storage position and coaxially connected unloading position; and a safety mechanism for preventing the crop material from spilling out when the auger is in the storage position. Thus, Claim 17 distinguishes over Hansen and Mooney for the reasons given above and is believed to be patentable thereover.

Claims 18, which is dependent on Claim 17, is believed to be patentable along with the parent Claim 17.

New Independent Claim 21

New independent Claim 21 combines the features of Claim 10 and 11 with the features of Claim 17. More specifically, Claim 21 recites: (1) the first segment and the second segment are pivoted in a horizontal plane between a storage position and coaxially connected unloading position; (2) no portion of the first segment and second segments extends beyond the rearmost end of the combine when the auger is in the storage position; (3) the hinged joint is lockable; and (3) and a safety mechanism for preventing the crop material from spilling out when the auger is in the storage position. Hansen and Mooney, singly or combined, do not teach or suggest any of the above-referenced features of Claim 21. Thus, Claim 21 is patentable thereover.

Lack of Motivation to Combine the References

In addition to the substantive arguments presented above, Applicants further assert that the 103(a) rejection is improper because no teaching, suggestion, or motivation for the combination of the Hansen and Mooney references exists. The mere fact that references can be combined or modified does not render the resultant combination obvious; the prior art must suggest the desirability of the combination. *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000); *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). The test is whether the combined teachings of the prior art, taken as a whole, suggest the modifications to the person of ordinary skill in the art. *In re Napier*, 55 F.3d 610, 34 USPQ2d 1782 (Fed. Cir. 1995).

In the present case, there can be no desirability to the combine references because the devices of the two references operate in totally different manner. For example, the Hansen reference teaches a self-unloading feed wagon using a horizontal conveyer, an elevator conveyer and a transverse conveyer. The Mooney reference, in contrast, teaches an auger wherein the respective auger flightings in the first and second parts are keyed together when the auger is unfolded for use to permit the flightings in the first part to rotatably drive the flighting of the second part. Conveyers and auger are two totally dissimilar mechanisms for unloading grain or feed.

Accordingly, there is not only a complete absence of a teaching or suggestion to make the combination, there can be utterly no motivation which would compel the

combination of two such totally and completely different mechanisms. The Section 103(a) reference is thus completely improper, and must be removed.

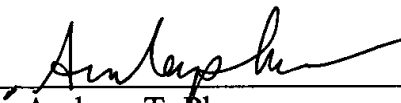
The References are an Inoperable Combination

Because of the dissimilar unloading operations of the cited references, Applicants further assert that the modification of Hansen by Mooney would render the Hansen invention inoperable and unsatisfactory for its intended use. A Section 103(a) rejection based upon a modification of a reference that destroys the intent, purpose, or function of the invention disclosed in the base reference, is not proper and a prima facie case of obviousness cannot be made. In short, there would be no technological motivation for engaging in the modification or change; instead, there would be a disincentive. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Hansen relies on a set of three conveyers. Mooney relies on a boom assembly consisting of a shaft and wings extending therein. Thus, modification of Hansen by Mooney would render the Hansen apparatus inoperative. Specifically, Hansen teaches conveyers, which is a principle completely opposite that is taught, and modified, by Mooney which teaches flightings. As such, combining the Hansen and Mooney references is inappropriate; thus, the Section 103(a) rejection of the claims should be withdrawn.

In summary, Claims 1-2, 4-6, 8, 10-11, 13, 15-18 and 21 are believed to be allowable for the reasons given herein. Accordingly, these claims remain pending following entry of this Amendment, and are in condition for allowance at this time. As such, Applicants respectfully request entry of the present Amendment and reconsideration of the application, with an early and favorable decision being solicited. Should the Examiner believe that the prosecution of the application could be expedited, the Examiner is requested to call Applicants' undersigned representative at the number listed below.

Respectfully submitted:

BY 

Andrew T. Pham
Attorney for Applicants
Registration No. 54,879

Case New Holland, Inc.
700 State Street
Racine, WI 53404
(262) 636-5368